USPTO PUBLISHES UPDATED SUBJECT MATTER ELIGIBILITY IN A NEW REVISION OF THE MANUAL OF PATENT EXAMINING PROCEDURE

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On January 30, 2018, the United States Patent and Trademark Office (USPTO) quietly published a new revision (Revision 08.2017) [1] to the Ninth Edition of the Manual of Patent Examining Procedure (MPEP). The revision includes amendments to a number of chapters, including notably the guidance regarding subject matter eligibility under 35 U.S.C. § 101. This includes changes in Chapter 2105 for living subject matter eligibility and Chapter 2106 for products of nature and software eligibility. The revision incorporates the contents of previous subject matter eligibility guidance documents that were provided on the "Subject Matter Eligibility" webpage [2] of the USPTO. Although the MPEP does not have the force of law, unlike the Code of Federal Regulations (CFR), patent examiners generally tend to follow the guidance provided in the MPEP. Accordingly, patent applicants dealing with Section 101 rejections should generally be starting with these revised MPEP chambers as a basis when crafting arguments to overcome such rejections.

Revised Chapter 2106 discusses the two-part Alice test [3] including guidance regarding whether an invention falls under one of the statutory categories and whether an invention is directed to a judicial exception for an abstract idea. Of particular note, chapter 2106.05 provides expansive guidance for determining whether a claim amounts to something "significantly more" than an abstract idea. These "significantly more" arguments are often the best avenue for overcoming Section 101 rejections.

While the examples and conclusions are not changed from the previous guidance, the revised MPEP provides a consolidation of previous Federal Circuit decisions grouped by the appropriate subject matter eligibility test. For example, Chapter 2106.05 is partitioned into separate sections for claims directed to (a) an improvement to the functioning of a computer, (b) a particular machine, (c) a particular transformation, (d) well-understood, routine conventional activity, (e) other meaningful limitations, (f) mere instructions to apply an exception, (g) insignificant extra-solution activity, and (h) a linking to a particular technological environment or field of use. The Federal Circuit cases discussed within each of these separate sections should make it easier for examiners and patent applicants to identify which set of cases most closely resembles the claims under examination.

A new Chapter 2106.07 provides formal guidance for examiners in making subject matter eligibility rejections and responding to responses from patent applicants. While subject matter eligibility rejections have generally improved, this section provides patent applicants a better foundation for challenging inadequate rejections that are made without sufficient consideration of the claim elements. In addition, this section addresses the preemption doctrine where patent applicants can argue that an invention is not abstract because it does not preempt a certain technical field. Preemption arguments typically do not receive much weight during patent

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examination. Going forward, chapter 2106.07(b) advises examiners to reconsider the eligibility analysis if the patent applicant argues that the claim is specific and does not preempt all possible applications of an "abstract idea:" "[s]uch reconsideration is appropriate because, although preemption is not a standalone test for eligibility, it remains the underlying concern that drives the two-part framework from Alice Corp." This formal guidance now in the MPEP should give preemption a greater weight when examiners consider subject matter eligibility.

While the MPEP has been revised, it appears the USPTO is maintaining the "Subject Matter Eligibility" webpage to reflect current Federal Circuit decisions that affect subject matter eligibility as well as to maintain the repository of examples applying the guidance (now MPEP sections) to hypothetical claims. Of particular note, the webpage includes a chart updated February 5, 2018, to reflect the holding from Finjan, Inc., v. Blue Coat Systems, Inc., [4] which is not discussed in the revised MPEP, and which was treated in another recent alert. K&L Gates will continue to monitor subject matter eligibility criteria and provide updates regarding any developments.

[1] MPEP 9th Edition, Revision 08.2017, USPTO, https://www.uspto.gov/web/offices/pac/mpep/index.html
[2] https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility
[3] Alice Corp. Pty. Ltd. v. CLS Bank Int'l., 573 U.S. _, 134 S. Ct. 2347, 2354, 110 USPQ2d 1976, 1980 (2014)
[4] Finjan, Inc., v. Blue Coat Systems, Inc., No. 2016-2520 at *3 (Fed. Cir. Jan. 10, 2018) ("system and method for providing computer security by attaching a security profile to a downloadable").

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